



Attorney Docket No. P71338US0

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of Marie-Phillipe BIRON

Application No. 10/583,088

Group Art Unit: 1637

Filed: June 15, 2006

Examiner: T. Strzelecka

For OLIGONUCLEOTIDES FOR THE DETECTION OF HEPATITIS B VIRUS

**RESPONSE  
TO REQUIREMENT FOR  
ELECTION OF SPECIES**

Commissioner for Patents  
P.O. Box 1450  
Alexandria VA 22313-1450

Sir:

This paper responds to the Office Action mailed October 8, 2008.

Pursuant to the requirement for election of species, species SEQ ID NO: 2, SEQ ID NO: 3, and SEQ ID NO: 8 is elected, with traverse. Claims 1-3 and 8-26 read on the elected species.

Traverse is maintained to the extent that any of claims 1-3, 8-14, 18-21, and 23-26 is not examined, i.e., to the extent that any of these claims is withdrawn from consideration pursuant to the requirement for election of species.

Only claims 15-17 and 22 are admitted by the PTO to read on every one of the species from which applicant must elect. Should the PTO refuse to examine any of claims 1-3, 8-14, 18-21, and 23-26 (identified by applicant—together with claims 15-17 and 22—as reading on the elected species), then the requirement for election of species effectively constitutes an improper *restriction* of invention (under 35 USC 121) by "refus[ing] to examine that which applicants regard as their invention." MPEP 803.02.

The election of species requirement is such that, on its face, only claims 15, 16, 17 and 22 (i.e. the generic claims) and their dependent claims can be found elected, i.e., can be examined, no matter what species applicant elects. This deprives applicant of the right to choose the aspect of the invention to be examined (e.g., an oligonucleotide consisting of SEQ ID NO: 2 as claimed in claim 2). *See* 35 USC 121.

As set forth in MPEP 814(II) "every claim should be accounted for" by the examiner unless "the correct disposition of the omitted . . . claim is clear." As explained above, "every claim is" not "accounted for" in the species from among which applicant must elect and "the correct disposition of the omitted . . . claim[s] is" not "clear," which renders the requirement for election of species improper. *See* MPEP 814(II).

Pursuant to MPEP 803.02:

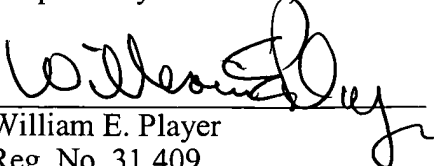
Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention.

The requirement for election of species fails to explain how "the subject matter" defined by any of claims 1-3, 8-14, 18-21, and 23-26 (identified by applicant—together with claims 15-17 and 22—as reading on the elected species) "lacks unity of invention" and, so, the requirement is "improper" for "refus[ing] to examine that which applicants regard as their invention." *See* MPEP 803.02.

Accordingly, applicant requests that the election of species requirement be withdrawn and that another proper election of species and/or restriction requirement be issued.

Favorable action is requested.

Respectfully submitted,



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